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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,806	02/02/2002	Rodney Morgan	402.401	9638

7590 12/29/2004
The Law Office of Debra J. Fickler
12525 Grandview Drive
Huntley, IL 60142-9501

EXAMINER

HUNTER, ALVIN A

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/061,806

Applicant(s)

MORGAN ET AL.

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/14/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because in line 4, "a adhesive" should read --an adhesive--. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4 and 9-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites "the golf club" in the preamble. The invention is directed to a cover for a golf club. What is the applicant trying to claim?

Claim 7 recites "the user" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 9 and 16 recites "the pre-adhesive side" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Tucker (USPN 4422638).

Regarding claim 1, Tucker discloses a golf club having a covering made of a resilient urethane material having an adhesive on the side thereof (See Abstract; Figures 1-6; and Column 4, lines 30 through 42).

Regarding claim 2, the covering is applied to a pre-manufactured golf club.

Regarding claim 3, the covering prevents damage to at least one surface of the head of the golf club.

Regarding claim 4, the golf club is a putter.

Regarding claim 5, the covering prevents damage from miss-strikings of a golf ball.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tucker (USPN 4422638).

Regarding claims 6 and 8, Tucker does not disclose the color of the covering. One having ordinary skill in the art would know that polyurethane is transparent and that the color and degree of transparency of the polyurethane may be control by the pigment

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added thereto; and therefore, would be obvious to use because of its ability to impose the aesthetics desired by the user.

Regarding claim 7, It is common within the art to place indicia thereon an object in order to identify the object, and therefore, would obvious to incorporate indicia thereon for such a reason.

Claims 9-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tucker (USPN 4422638) in view of OFFICIAL NOTICE.

Regarding claims 9-11, 13, 15-18, 20, 21, and 23, Tucker discloses a covering for a surface of a golf club head wherein a pre-adhesive side of the urethane protective covering is applied to the surface of the club head, but does not explicitly disclose cleaning the surface of the club head. OFFICIAL NOTICE is taken that it is common known to clean a metal surface with alcohol before adhering an element thereto. Therefore, one having ordinary skill in the art would have found it obvious to do such in order to remove dirt therefrom to increase the adhesion. Having indicia thereon the covering does not distinguish claim 16 from that of claim 9 because the ideology of the method is the same, therefore, it is submitted that the above also meets the limitations of claims 16-18, 20, 21, and 23.

Regarding claim 12, Applicant does not disclose why the use of only isopropyl alcohol is critical to attain the invention. Isopropyl alcohol is common know as a disinfectant, in which ethyl alcohol is also. One having ordinary skill in the art would have found it obvious to use any type of rubbing alcohol to clean the surface so long as it disinfects the surface area desired.

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Regarding claim 14, Tucker discloses the entire club head covered by urethane. Therefore, trimming would be an inherent step to remove excess flash created by the molding process.

Regarding claim 19, Applicant does not disclose why the use of only isopropyl alcohol is critical to attain the invention. Isopropyl alcohol is common known as a disinfectant. Ethyl alcohol is also. One having ordinary skill in the art would have found it obvious to use any type of rubbing alcohol to clean the surface so long as it disinfects the surface area desired.

Regarding claim 22, Tucker discloses the entire club head covered by urethane. Therefore, trimming would be an inherent step to remove excess flash created by the molding process.

Regarding claim 24, it is common within the art for most indicia to comprising pigment being that most indicia comprise coloring different from that of the surface it is applied to.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 571-272-4415. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAH
Alvin A. Hunter, Jr.


GREGORY VIDOVICH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700